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AUG 16 2010

In re Application of
Teoh, et al.
Application No. 10/828,477
Filed/Deposited: 20 April, 2004
Attorney Docket No. 4459.1006-001

: OFFICE OF PETITIONS
: DECISION ON PETITION
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This is a decision on the petition filed on 12 July, 2010, pursuant to 37 C.F.R. §1.183 to suspend the rules—specifically, the requirements of the regulations at 37 C.F.R. §1.132.

NOTES:

Petitioner seeks relief pursuant to 37 C.F.R. §1.183, but fails to make a showing that she—Petitioner—has made an effort to seek out information in this matter.

Rather, Petitioner places all of the duties in the hands of one not registered to practice before the Office.

This is not appropriate.

Petitioners always are reminded that those registered to practice **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to inquire and disclose.¹ Registered practitioners do not satisfy this requirement simply by placing into the statements others the required showings herein.

Petitioner must make the showing with proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the papers in question (declaration with any necessary specification: description, claims and drawings); with a statement of the last known address of the non-signing inventor(s)—

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

Should Petitioner wish to renew her petition, she must make the showing required—i.e., her independent inquiry—as discussed below.

The petition pursuant to 37 C.F.R. §1.183 is **DISMISSED**.

BACKGROUND

The record indicates:

On 8 April, 2010, former Counsel sought to file statements/declarations by the co-inventors herein pursuant to the regulations at 37 C.F.R. §1.132, and was able to submit statements from co-inventors Teoh, Hutmacher, KC Tan and KF Tan for themselves and on behalf of Iwan Zein. However, it does not appear that the signature of Iwan Zein was obtained at that time.

About two (2) months later, on 24 May, 2010, Petitioner Vivien J. Tannoch-Magin (Reg. No. 56,120) (Petitioner) sought to enroll as Counsel of record pursuant to a Revocation/Power of Attorney submitted that date, and that submission was accepted by the Office on 25 May, 2010.

On 12 July, 2010, Petitioner sought waiver pursuant to 37 C.F.R. §1.183 of the requirements of to 37 C.F.R. §1.132, averring that the non-signing inventor Iwan Zein refused to sign or could not be found, and in support of that averment, Petitioner submitted (along with a two- (2-) page photocopy of an envelope and non-delivery receipt) a two- (2-) page statement/declaration by Nerliza Ismail (Ms. Ismail), identified as “the Management Assistant Officer from NUS Industry Liaison who attempted to contact inventor Iwan Zein on behalf of the Applicant, Osteopore International Ltd ***.”

There is no indication that Ms. Ismail is registered to practice before the Office and, thus, she may or may not appreciate the duties of diligence, inquiry and candor expected of all who present to the Office.

However, Petitioner, as one registered to practice before the Office, well appreciates those duties.

Thus, Petitioner is expected to undertake her own inquiry in this matter—i.e., as to the showing that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the papers in question (declaration with any necessary specification: description, claims and drawings); with a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address. And Petitioner must present to the

Office the evidence of that inquiry and its result(s)—consistent with her continuing duty to inquire and to disclose and to do so with candor²—on any renewed petition.

ANALYSIS

Suspension of the rules pursuant to 37 C.F.R. §1.183 may be granted in an “extraordinary situation, when justice requires.”

Specifically, the regulations at 37 C.F.R. §1.183 set forth the conditions required for their invocation/application:

§1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(f). (Emphasis supplied.)

It does not appear that Petitioner has as of this writing demonstrated the extraordinary situation for which Petitioner sought, *inter alia*, suspension of the rules (i.e., the requirements of the regulations at 37 C.F.R. §1.132) pursuant to 37 C.F.R. §1.183.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

CONCLUSION

Accordingly, the petition considered pursuant to 37 C.F.R §1.183 (for waiver of the regulations at 37 C.F.R §1.132) is **DISMISSED**.

The instant application is released to Technology Center/AU 1647 for further processing in due course.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of Petitioners or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.